

### REMARKS/ARGUMENTS

The final Office Action mailed January 21, 2010 has been received and the Examiner's comments carefully reviewed. Claims 1-20 are rejected. Claims 1, 10 and 16 have been amended. Claim 6 was canceled. The Applicants present the following for consideration.

#### Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1, 3, 5-7, and 9 are rejected under 35 U.S.C. 103(a) as being obvious over Schwartz et al, U.S. Patent Publication No. 200410135816 ["Schwartz"] in view of Kobashikawa et al, U.S. Patent No. 7.539.699 [Kobashikawa"]. Claims 10, 11, and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang et al, U.S. Patent No. 5.966.714 ["Huang"], in view of Kobashikawa and Schwartz. Claims 16, 19, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang in view of Kobashikawa. Claims 12, 14, and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang and Kobashikawa, in further view of Kraenzel et al, U.S. Patent Publication No. 200510198144 ["Kraenzeri]. Claims 13 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Huang and Kobashikawa, in further view of Lake, U.S. Patent No. 7,200,638. Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Schwartz and Kobashikawa, in further view of Kraenzel. Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Schwartz and Kobashikawa, in further view of Lake. Claim 8 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Schwartz and Kobashikawa, in further view of Calder et al, U.S. Patent Publication No. 2001/0034244 [Calder"]. In response, the claims have been amended to more clearly define the invention.

Claim 1, as amended, recites in part "providing from the server the GAL contacts to the device; wherein the GAL contacts are automatically incorporated with the user's personal contacts and wherein a display of the GAL contacts are visually distinguishable from the user's personal contacts when displayed together within a contact view on the device; wherein the user's personal contacts are treated differently from the provided GAL contacts such that the user's personal contacts are maintained during a synchronization that updates the provided GAL contacts; wherein a provided GAL contact is automatically added to the user's personal contacts when the user first edits the provided GAL contact on the device such that the provided GAL contact that was edited is one of the user's personal contacts during a next synchronization."

Among other differences, Schwartz does not teach automatically adding a GAL contact to the personal contacts of a user upon an edit to one of the provided GAL contacts.

In contrast, Schwartz teaches obtaining likely recipients and keeps a list of recipients based on communications to the recipients. Schwartz teaches that in order to be considered a likely recipient the recipient must be included within the user's address book. Paragraph 44 of Schwartz recites in part that "As such, a user is prompted by the present invention to add a non-address book recipient to the address book. The prompt occurs when a user enters a given non-address book recipient for the nth time. In one embodiment of the present invention, a configurable 'n' number of seven is utilized for prompting the user. As a result, the seventh time that a message is addressed to a non-address book recipient, the user will be prompted to add that recipient to the address book." As can be seen, Schwartz teaches that a user is prompted before the contact is added to a user's address book. Further, Schwartz does not teach that this occurs upon a first edit to a contact. The addition of the other cited references fail to cure these deficiencies. For example, Huang teaches generating a personal address book and keeping the personal address book synchronized with a master database. (Col. 4, lines 15-18) Huang teaches in Figure 3E the general steps in which an address is processed. At col. 10, lines 1-8, Huang recites that "In step 351, it is determined whether or not the address is in an additional information source (PIM, contact database, etc.). If the address of the message is in an additional data source, then in step 352, additional information regarding the address is obtained from the additional source. In step 353, if there is any manual information (i.e. input from user) to be added regarding the address, then in step 354, additional information is obtained from the user." Processing an address, however, does not teach adding automatically adding GAL contact that is edited as a personal contact. The Kobashikawa reference teaches searching through emails to find addresses to add to an address book. The Kobashikawa reference, however, does not teach that an edited GAL contact is automatically added to a user's personal contacts. Since Schwartz, or the other cited references, fail to teach the recitations, Claim 1 is proposed to be allowable. Claims depending from Claim 1 are proposed to be allowable as they depend on a valid base claim.

As amended, Claim 10 recites in part "displaying the GAL contacts on the display; and when an edit is made to one of the GAL contacts while stored on the device automatically adding

the edited GAL contact as a personal contact to the user's personal contacts on the device such that the edited GAL contact is one of the user's personal contacts during a next synchronization." Claim 10 is proposed to be allowable for at least reasons presented above. Claims depending from Claim 10 are proposed to be allowable as they depend on a valid base claim.

As amended, Claim 16 recites in part "automatically selecting global address list (GAL) contacts for a user that are in addition to a user's personal contacts on the device and that are unique from the user's personal contacts from the user's emails; wherein the GAL contacts on the device are synchronized differently from the user's personal contacts on the device such that when a GAL contact is deleted on the device, a record is maintained indicating to remove the GAL contact from the automatically selected GAL contacts before providing the GAL contacts to the device during a subsequent synchronization; and wherein the GAL contacts are visually distinguishable within a contact view on the device from the user's personal contacts; wherein a GAL contact is automatically added to the user's personal contacts when the user first edits the GAL contact on the device such that the GAL contact that was edited is one of the user's personal contacts during the subsequent synchronization." Claim 16 is proposed to be allowable for at least reasons presented above. Claims depending from Claim 16 are proposed to be allowable as they depend on a valid base claim.

Conclusion

In view of the foregoing amendments and remarks, all pending claims are believed to be allowable and the application is in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. Should the Examiner have any further issues regarding this application, the Examiner is requested to contact the undersigned attorney for the applicant at the telephone number provided below.

Respectfully submitted,  
MERCHANT & GOULD P.C.

P.O. Box 2903  
Minneapolis, MN 55402-0903  
206.342.6200

/Timothy P. Sullivan/  
Timothy P. Sullivan  
Reg. No. 47,981  
Direct Dial 206.342.6254

